

**REMARKS***Claim Amendments*

Claims 1-3, 13-16 and 18-20 are amended herein. Specifically, Applicant has amended independent claims 1, 13 and 15 and their respective dependent claims 2-3, 14, 16 and 18-20 herein so the body of the claim depends on its preamble. That is, Applicant has amended each of the above claims to clarify that the language in the claim's preamble is a limitation on the body of the claim.

*Claim Rejections Under 35 U.S.C. § 102*

Claims 1-4, 6-8 and 11 were rejected under 35 U.S.C. § 102 as being anticipated by Admitted Prior Art (the APA) (figure 1; background section of the specification). Applicant assumes, since the specific subsection of 35 U.S.C. § 102 was not indicated by the Examiner, that the rejection was under 35 U.S.C. § 102(b) and responds as such. Applicant respectfully traverses this rejection and submits that claims 1-4, 6-8 and 11, as amended, are allowable for the following reasons.

In rejecting claims 1-4, 6-8 and 11, the Examiner stated, “[r]egarding claim 1, APA teaches an imaging device comprising: an image generator (110), wherein the image generator is a print engine (Paragraph 0002, lines 8- 10); a network interface (paragraph 0004, lines 12-14); and a controller (104) coupled to the network interface and the image generator (figure 1; via network backplane 100), wherein the controller is adapted to store a list of other network addresses (paragraph 0005, lines 1 -3). The preamble has not been given patentable weight because a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).”

As stated above, Applicant has amended independent claim 1 herein so the body of the claim depends on its preamble. That is, Applicant has amended claim 1 to clarify that the language in the claim's preamble is a limitation on the body of the claim.

Applicant disagrees with the Examiner's assessment of the limitations of claim 1 and maintains that the Examiner is impermissibly reading an overly broad interpretation of the claims

that is contrary to the definitions of the terms and limitations of the claims in the Specification. In addition, Applicant respectfully maintains that the Examiner's interpretation is also contrary to the interpretation that would be given these terms by one skilled in the art. Applicant respectfully contends that one skilled in the art would not interpret "an imaging device" as being spread across multiple devices. Applicant also respectfully maintains that the claims, as currently amended, specifically covers the embodiment of an imaging device having an internal print engine, an internal controller, and network interface, wherein the imaging device internally stores a list of network addresses of other imaging devices.

Applicant understands that the Examiner is entitled to read the claims as broadly as possible. However, as stated by MPEP §2111, this reading must be done to give the pending claims their "broadest reasonable interpretation consistent with the specification," and that "[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach." In addition, as stated in MPEP §2111.01, "the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification," and that "[a]n applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s)."

Specifically, Applicant respectfully contends, as stated in the Response mailed on December 5, 2005, "imaging devices similar to the imaging device" are described, at least, by Paragraph [0022] of the present Specification, that states "[s]imilar imaging devices, for the purposes of this disclosure, are defined as imaging devices similar with regard to manufacturer, imaging device type, or features." In addition, Applicant maintains that an imaging device with a print engine is described, at least, by Paragraph [0002] of the present Specification, that states "[i]maging devices typically produce either a hard or soft copy of any particular imaging job the device is given using an appropriate image generator. If the imaging device produces a hard copy, its image generator is often referred to as a print engine, which produces a hard copy on the appropriate print media." *See*, Specification of the Present Application, Paragraph [0002], Line 10-14 and Paragraph [0022], Lines 13-15.

Applicant thus contends that relevant features and terms of the claims are therefore described in the specification and definite and, as such, do not support the overly broad interpretation of these terms and the claims as maintained by the Examiner.

As such, Applicant respectfully maintains that the APA discloses a system for managing imaging devices 110, 102 on a network 100, having a separate management facility 104 (and not a internal controller of an imaging device, as maintained by the Examiner) that connects to the imaging devices 102, 110 across the network. Applicant further maintains that Paragraph [0005] of the APA cited by the Examiner for stating that the management facility 104 is adapted to store a list of other network addresses, does not state that the management facility 104 is adapted to store a list of other network addresses, but only states that management facilities use such lists and describes how they are loaded into the management facility for use. Applicant also disagrees with the Examiner's interpretation of the inherency of discovery protocols and that discovering an imaging device on a network is equivalent of a second imaging device alerting a first imaging device that it is on the network. *See*, APA, Figure 1; Paragraphs [0004]-[0005]. Applicant therefore respectfully submits that the APA fails to teach or disclose all elements of the Applicant's claimed invention.

Applicant's claim 1, as amended, recites "[a]n imaging device comprising: an image generator, wherein the image generator is a print engine internal to an imaging device; a network interface, wherein the network interface is adapted to couple the imaging device to a network; and a controller coupled to the network interface and the image generator, wherein the controller is internal to the imaging device and is adapted to store a list of other imaging device network addresses." As detailed above, Applicant submits that the APA fails to teach or disclose such an imaging device that is adapted to store a list of other imaging device network addresses. As such, the APA fails to teach or disclose all elements of claim 1.

Applicant respectfully contends that claim 1, as pending, has been shown to be patentably distinct from the cited reference. As claims 1-4, 6-8 and 11 depend from and further define claim 1, they are also considered to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) and allowance of claims 1-4, 6-8 and 11.

Claims 1 and 5 were rejected under 35 U.S.C. § 102(e) as being anticipated by Helms (U.S. Patent No. 6,965,931). Applicant respectfully traverses this rejection. Applicant reserves the right to swear behind the reference Helms, but submits that claims 1 and 5, as amended, are allowable for the following reasons.

As stated above, Applicant has amended independent claim 1 herein so the body of the claim depends on its preamble. That is, Applicant has amended claim 1 to clarify that the

language in the claim's preamble is a limitation on the body of the claim. As also stated above, Applicant disagrees with the Examiner's overly broad interpretation of the claims given the definition of the terms in the Present Specification. Applicant specifically notes that "print engine" is defined as an internal image generator of an imaging device that "produces a hard copy on the appropriate print media." *See*, Paragraph [0002], Lines 10-14 of the Present Specification.

Applicant respectfully maintains that Helms discloses a network appliance 402 that incorporates a "thin" print server functionality to allow it to queue print jobs from network computers 404 and serve the print jobs across a network to one or more imaging devices 410. Applicant respectfully contends that a print server is not an imaging device having an internal image generator that is a print engine which produces a hard copy on the appropriate print media. *See*, Helms, Figure 4; Column 7, line 25 to Column 8, line 15. Applicant therefore respectfully submits that Helms fails to teach or disclose all elements of the Applicant's claimed invention.

Applicant's claim 1 recites "[a]n imaging device comprising: an image generator, wherein the image generator is a print engine internal to an imaging device; a network interface, wherein the network interface is adapted to couple the imaging device to a network; and a controller coupled to the network interface and the image generator, wherein the controller is internal to the imaging device and is adapted to store a list of other imaging device network addresses." As detailed above, Applicant submits that Helms fails to teach or disclose such an imaging device that is adapted to store a list of other imaging device network addresses. As such, Helms fails to teach or disclose all elements of claim 1.

Furthermore, Applicant respectfully calls attention to 35 U.S.C. § 103(c) which indicates that Helms, being available as a reference only under 35 U.S.C. § 102(e), may not be used as a basis for a § 103 rejection being commonly assigned to the same entity as the current application at the time of invention.

Applicant respectfully contends that claim 1, as pending, has been shown to be patentably distinct from the cited reference. As claim 5 depends from and further defines claim 1, it is also considered to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e) and allowance of claims 1 and 5.

Claims 1, 7, 9, 10 and 13-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Simpson et al. (U.S. Published Application No. 2003/0055874). Applicant reserves the right to swear behind the reference Simpson et al., but submits that claims 1, 7, 9, 10 and 13-20, as amended, are allowable for the following reasons.

As stated above, Applicant has amended independent claims 1, 13 and 15 and their respective dependent claims 14, 16 and 18-20 herein so the body of the claim depends on its preamble. That is, Applicant has amended each of the above claims to clarify that the language in the claim's preamble is a limitation on the body of the claim. As also stated above, Applicant disagrees with the Examiner's overly broad interpretation of the claims given the definition of the terms in the Present Specification. Applicant specifically notes that "print engine" is defined as an internal image generator of an imaging device that "produces a hard copy on the appropriate print media," and that similar imaging devices are defined as imaging devices that are "similar with regard to manufacturer, imaging device type, or features." *See*, Paragraph [0002], Lines 10-14 and Paragraph [0022], Lines 13-15 of the Present Specification.

Applicant respectfully maintains that Simpson et al. discloses a system for recognizing devices connected in a distributed processing environment, such as a network, wherein a server 350 discovers the devices and maintains a database of information on them. Applicant respectfully contends that server 350 is not an imaging device having an internal image generator that is a print engine which produces a hard copy on the appropriate print media. Applicant also contends that server 350 and the imaging devices (printers) 320, 330 are also not "similar" imaging devices as defined by the Present Specification. *See*, Simpson et al., Figure 3; Paragraph [0038]. Applicant therefore respectfully submits that Simpson et al. fails to teach or disclose all elements of the Applicant's claimed invention.

Applicant's claim 1 recites "[a]n imaging device comprising: an image generator, wherein the image generator is a print engine internal to an imaging device; a network interface, wherein the network interface is adapted to couple the imaging device to a network; and a controller coupled to the network interface and the image generator, wherein the controller is internal to the imaging device and is adapted to store a list of other imaging device network addresses." As detailed above, Applicant submits that Simpson et al. fails to teach or disclose such an imaging device that is adapted to store a list of other imaging device network addresses. As such, Simpson et al. fails to teach or disclose all elements of claim 1.

Applicant's claim 13 recites "[a] computer-usable medium having computer readable instructions stored thereon for execution by a processor of an imaging device to perform a

method comprising: determining a list of network addresses for other imaging devices similar to a first imaging device, wherein the first imaging device contains a print engine; storing the list of network addresses on the first imaging device; and communicating with the other similar imaging devices by referring to the list of network addresses for the other imaging devices.” As detailed above, Applicant submits that Simpson et al. fails to teach or disclose such a computer-usable medium and method for execution by a processor of an imaging device to store a list of other similar imaging device network addresses. As such, Simpson et al. fails to teach or disclose all elements of claim 13.

Applicant’s claim 15 recites “[a] method of operating an imaging device, the method comprising: determining a list of network addresses for other imaging devices similar to a first imaging device, wherein the first imaging device contains a print engine; storing the list of network addresses on the first imaging device; and referring to the list of network addresses of other imaging devices for communication between imaging devices.” As detailed above, Applicant submits that Simpson et al. fails to teach or disclose such a method of operating an imaging device that determines and stores a list of other similar imaging device network addresses. As such, Simpson et al. fails to teach or disclose all elements of claim 15.

Furthermore, Applicant respectfully calls attention to 35 U.S.C. § 103(c) which indicates that Simpson et al., being available as a reference only under 35 U.S.C. § 102(e), may not be used as a basis for a § 103 rejection being commonly assigned to the same entity as the current application at the time of invention.

Applicant respectfully contends that claims 1, 13 and 15, as pending, has been shown to be patentably distinct from the cited reference. As claims 7, 9-10, 14, and 16-20 depend from and further define claims 1, 13 and 15, respectively, they are also considered to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e) and allowance of claims 1, 7, 9, 10 and 13-20.

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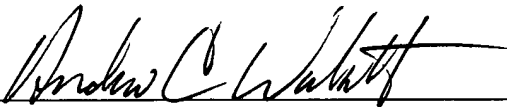
**CONCLUSION**

In view of the above remarks, Applicant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. Please charge any further fees deemed necessary or credit any overpayment to Deposit Account No. 08-2025.

If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2207.

Respectfully submitted,

Date: 6/13/06



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